

REISSUE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: Leo A. Whiteside	GROUP:
PATENT NO.: U. S. Patent 5,766,260	EXAMINER:
ISSUED: June 16, 1998	
FOR: Acetabular Component With Improved Liner Seal and Lock	

St. Louis, Missouri

**REISSUE APPLICATION DECLARATION AND POWER OF
ATTORNEY BY INVENTOR**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name, I believe that I am an original and first inventor of the subject matter described and claimed in Letters Patent Number 5,766,260 ("the '260 Patent"), granted on June 16, 1998 on the invention entitled "Acetabular Component With Improved Liner Seal and Lock", the specification of which is attached hereto.

The above-identified patent was assigned to Surgical Technologies, Inc. (now Whiteside Biomechanics, Inc.) and such assignment was recorded in the U.S. Patent and Trademark Office on June 6, 1995 on Reel 7519, Frame 0922.

Acknowledgement of Review of Papers and Duty of Candor
(37 CFR § 1.175)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information that is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

In compliance with this duty, an Information Disclosure Statement in accordance with 37 CFR § 1.98 will be furnished, if applicable.

No claim of priority under 35 USC § 119(a) – (d) is made.

Statement of Inoperativeness or Invalidity of Original Patent

1. I believe the original patent to be partly inoperative or invalid by reason of a defective specification in that I claimed less than I had a right to claim in the patent. This failure occurred because my attorney failed to appreciate the full scope of the invention.

2. I also declare that the errors listed below, which are being corrected, up to the time of filing of this reissue declaration, arose without any deceptive intention on the part of the applicant.

3. My original patent application which ultimately resulted in the issuance of the '260 patent for which a broadening reissue is being sought with this reissue application, was originally filed on June 6, 1995 as U. S. Patent Application No. 08/466,607. On April 28, 1997, continuation U. S. Patent Application No. 08/847,887 was filed.

4. My original application included 6 claims, a copy of which is attached hereto as Exhibit 1.

5. At the time the original patent application was filed, I believed the invention in its most basic form resided in a prosthesis comprising two primary components; a shell and a liner. More specifically, the invention resided in the use of two annular ridges protruding from the outer surface of the liner which, when placed in contact with the inner surface of the shell,

provided a sealing engagement with the inner surface of the shell which prevented the migration of debris from the inner surface of the liner into the space between the outer surface of the liner and the inner surface of the shell. I believed that the attorney's effort in preparing the patent application would result in patent claims broad enough to provide protection against any other devices that incorporated the use of the two sealing ridges on the outer surface of the liner to seal the interior of the shell.

6. As another additional element of the invention, an interlocking mechanism consisting of a locking ridge could be made integral with the outer surface of the liner. The locking ridge could engage with an interlocking groove on the inner surface of the shell, and the engagement of the locking ridge and the interlocking groove provided one way in which the liner could be retained within the shell. Another method of locking the liner and the shell together was by the incorporation of a plurality of generally rounded peripheral tabs on the edge of the liner which engaged notches in the shell which, by means of a pair of inwardly projecting lips, grasped the tabs to retain the liner into the shell.

7. In the First Office Action provided by Examiner B. Snow on September 11, 1995, the Examiner rejected all of the claims in my original patent application as being unpatentable over Tronzo (4,681,589) and Muller (4,936,861). In particular, the Examiner identified the interlocking rings 48 and 50 and the interlocking grooves 52 and 54 in Tronzo as being analogous to the sealing ridges of my invention. (See Exhibit 2).

8. The Examiner rejected my original claims as anticipated by Tronzo and Muller regarding the sealing ridges and the separate interlocking groove components of my invention.

9. In response to the first Office Action, my attorney argued that the interlocking rings and interlocking grooves in Tronzo were not seals and that the interlocking rings were

separate and distinct from the sealing aspect of the sealing ridges of my invention. (See Exhibit 3).

10. Throughout pages 3, 4, and 5 of my attorney's response to the Examiner's First Office Action, my attorney continues to argue that the functions and characteristics of the sealing ridges in the liner of my invention are totally separate and distinct from the interlocking grooves. (See Exhibit 4).

11. In the Final Office Action of Examiner B. Snow on April 26, 1996, the Examiner found my attorney's arguments regarding the distinction between the sealing ridges and the interlocking ridge were unpersuasive and rejected all the claims of my application.

12. In response to the Examiner's Final Office Action, my attorney filed an Amendment B with the Patent Office in which the exceptions noted by the Examiner in his Final Office Action were addressed. In this response, my attorney cancelled the original claims 1, 4, 5, 8, 9, and 11 in my original patent application, amended claims 2, 3, 6, 7, and 10, and offered a new claim 16. (See Exhibit 5).

13. It was in this response to the Examiner's Final Office Action that the attorney committed the error which requires me to file the present Reissue Application.

14. Although my attorney cancelled original claims 1, 3, 5, 8, 9, and 11, there was no basis for doing so.

15. The new claim 16 offered by my attorney still incorporated all of the individual elements disclosed by me for my invention and none of the drawings were revised in any way to modify the separate sealing ridges and separate interlocking option of my invention.

16. Although the claims in my original application clearly delineate the separate character of the sealing ridges from the interlocking rings by incorporating these separate

structural elements into individual claims, my attorney erroneously combined the sealing rings and the interlocking groove into a single new claim, claim 16.

17. There was no basis in any of the Examiner's Office Actions for my attorney to make these amendments and the amendments were not offered in response to overcome any arguments regarding patentability because the new claim 16 retained all of the structural components objected to by the Examiner.

18. While my attorney erroneously offered an improperly constructed new claim 16 in his response to the Final Office Action, it should be noted that he nevertheless continued to offer arguments in support of the fact that the sealing rings and the interlocking mechanism of my invention were two separate and distinct elements. (See Exhibit 5, pages 4-6). As an example of those arguments, my attorney stated on page 4, second paragraph, "The liner has at least one circumferential seal and a separate locking ridge designed to engage an interlock formed in the inner surface of the acetabular shell."

19. In a subsequent Advisory Action, the Examiner made a final rejection of all of the claims of my original patent application.

20. A File Wrapper Continuing Application was filed with the Patent Office on April 28, 1997 to continue the prosecution of the claims as they existed after my attorney's response to the Examiner's Final Office Action.

21. As a result of that continuing application, amended claims 2, 3, 6, and 7, along with the erroneously submitted new claim 16 offered by my attorney in the response to the Examiner's Final Office Action, were allowed by the Patent Office in a Notice of Allowability issued on September 9, 1997.

22. Patent 5,766,260 issued on June 16, 1998.

23. As noted in paragraph 6 above, there were two methods of retaining the liner into the shell. One method used an interlocking mechanism consisting of a locking ridge which could be made integral with the outer surface of the liner. The locking ridge could engage with an interlocking groove on the inner surface of the shell, and the engagement of the locking ridge and the interlocking groove provided one way in which the liner could be retained within the shell. A second method of locking the liner and the shell together was by the incorporation of a plurality of generally rounded peripheral tabs on the edge of the liner which engaged notches in the shell which, by means of a pair of inwardly projecting lips, grasped the tabs to retain the liner into the shell.

24. In reviewing the issued patent, it is clear that while my attorney properly claimed the second method of locking the liner to the shell as a separate dependant Claim 6 of the '260 Patent, my attorney erred by failing to also claim the first method of locking the liner to the shell as another separate dependant claim. Instead, the attorney erroneously incorporated the first locking method into the fourth paragraph of independent Claim 1 as a structural element of that independent Claim. In doing so, Claim 1 is a narrower claim than I am entitled to in light of the disclosure in my original patent application.

25. In addition to the error committed by incorrectly including the interlocking element into Claim 1, my attorney also erred by changing the name of the invention from "a prosthesis" to "an acetabular component."

26. I believed that the invention as disclosed within the original patent application covered a device for use in all situations wherein a prosthesis was to be used to replace a skeletal joint in humans, or in animals treated by veterinarians. I believed this because of the statements contained within column 6, lines 32-39 of the '260 Patent which states:

“While the prosthesis component of the present invention has been described as an acetabular component of a hip replacement system, this description is not intended to be limiting. The prosthesis component of the present invention can be utilized in other articulating anatomical joint systems, such as shoulder joint systems, and not limited to ball and socket joints, and is equally suited for other types of uses, including veterinarian applications.”

27. However, the actual wording of all six Claims of the ‘260 Patent establish the invention as being an “acetabular component,” thereby limiting the claims to cover only hip replacement components. Thus, an error was made in that all six claims of the ‘260 Patent claim an invention relegated to hip replacement, i.e., acetabular, components.

28. Upon examination of the entirety of the original disclosure, a person having ordinary skill in the art of prosthesis design would find that I could have fairly claimed the invention as not requiring the interlocking mechanism. In fact, it would be clear that my invention, as now claimed in the reissue claim offered herein, actually relies on the invention of the liner having annular ridges for sealing the inner surface of the shell from debris, rather than the type of locking mechanism used to captivate the liner into the shell.

29. Additionally, upon examination of the entirety of the original disclosure, a person having ordinary skill in the art of prosthesis design would find that I could have fairly claimed the invention as residing in a prosthesis for use in other articulating anatomical applications other than hip replacement systems requiring acetabular components.

30. Therefore, notwithstanding the clarity of the invention disclosed in the original patent application, my attorney committed two errors. First, my attorney erroneously included a structural interlocking mechanism in all embodiments of my invention by incorporating that interlocking mechanism into independent Claim 1, the Claim from which all other dependant claims in the issued patent depend.

31. Second, my attorney erred by renaming my invention as an "acetabular component" thereby narrowing the scope of my invention such as not to cover the use of my invention in other articulating anatomical uses.

32. It is clear from my attorney's actions in committing these errors that he failed to appreciate the full scope of my invention.

33. This failure to appreciate the full scope of the invention resulted in the patent application having narrower claims than were allowable from the disclosure of the original patent application.

34. Reissue is needed, therefore, in order to broaden the scope of United State Patent 5,766,260 to provide the full scope of protection to which I believe my invention is entitled. I believe that the amended and added claims contained in the attached Preliminary Amendment provide the full scope of protection to which I am entitled for the invention described within that specification.

35. I consent to the surrender of United States Letter Patent Number 5,766,260 in order to obtain a reissue of that patent and will make such surrender in the event the above errors are corrected and there is a reissuance of the '260 patent to correct these errors.

Corroborating affidavits or declarations of others accompany this Declaration.

Power of Attorney

I hereby appoint the following practitioners to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected therewith.

I hereby appoint the following attorneys to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith: Philip B. Polster, Reg. No. 16,554, Frederick M. Woodruff, Reg. No. 15,301, J. Philip Polster, Reg. No. 24,739, Lionel L. Lucchesi, Reg. No. 25,891, William G. Bruns, Reg. No. 19,541, Edward A. Boeschstein, Reg. No. 22,986, William B. Cunningham, Jr., Reg. No. 26,155, Ralph B. Brick, Reg. No. 17,444, Michael Kovac, Reg. No. 22,140, McPherson D. Moore, Reg. No. 28,449, J. Joseph Muller, Reg. No. 28,450, Richard J. Sher, Reg. No. 27,282, Jonathan P. Soifer, Reg. No. 34,932, Ned W. Randle, Reg. No. 35,989, Martha A. Michaels, Reg. No. 20,453, Mark E. Books, Reg. No. 40,918, Catherine W. Wall, Reg. No. 42,209, and Philip B. Polster, II, Reg. No. 43,864.

Direct all telephone calls to William B. Cunningham, Jr. at Telephone No. (314) 872-8118, Fax 314-991-2178, email: wcunning@patpro.com.

Address all correspondence to Customer Number 001688.

Declaration

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

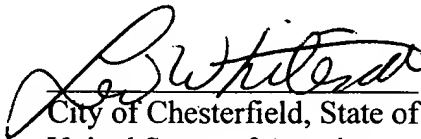
Full name of Inventor: Leo A. Whiteside

Inventor's Signature:

Residence:

Citizenship:

Post Office Address:

 Date: 6-12-00
City of Chesterfield, State of Missouri
United States of America
14825 Sugarwood Trail, Chesterfield, MO 63005

REISSUE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


INVENTORS: Leo A. Whiteside	GROUP:
PATENT NO.: U. S. Patent 5,766,260	EXAMINER:
ISSUED: June 16, 1998	
FOR: Acetabular Component With Improved Liner Seal and Lock	

St. Louis, Missouri

ASSENT OF ASSIGNEE

Whiteside Biomechanics, Inc., a corporation of the State of Missouri having its principal office and place of business at 12634 Olive Boulevard, St. Louis, Missouri, 63141, the sole assignee of all right, title, and interest in United States Patent 5,766,260 under an assignment recorded in the United States Patent Office on June 6, 1995 on Reel 7519, Frame 0922, hereby assents to this application for reissue of United States Patent 5,766,260 and to the reissue of that patent. It further assents to the power of attorney. It offers to surrender United States Letters Patent 5,766,260 in order obtain reissue of that patent.

Whiteside Biomechanics, Inc.

By 
Leo A. Whiteside
President

St. Louis, Missouri
June 13, 2000

REISSUE

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INVENTORS: Leo A. Whiteside	GROUP:
PATENT NO.: U. S. Patent 5,766,260	EXAMINER:
ISSUED: June 16, 1998	
FOR: Acetabular Component With Improved Liner Seal and Lock	

St. Louis, Missouri

St. Louis, Missouri

June 13, 2000

Assistant Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF OWNERSHIP UNDER 37 C.F.R. 3.73(b)

The undersigned on behalf of Whiteside Biomechanics, Inc., a corporation of the State of Missouri with its principal place of business at St. Louis, Missouri, certifies that:

1. Whiteside Biomechanics, Inc. owns the invention entitled Acetabular Component With Improved Liner Seal and Lock which forms the subject of United States Letters Patent 5,766,260 designated above.
2. Whiteside Biomechanics, Inc. owns United States Letter Patent 5,766,260, having formally acquired title through an Assignment recorded against Application 08/466,607 and thereby on the continuation of that Application, 08/847,887, on which the patent issued. The Patent Office recorded that Assignment on July 31, 1992, at Reel 7519, Frame 0922.

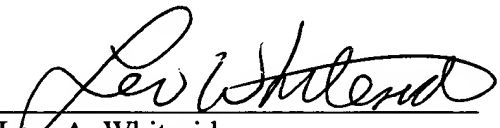
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3. Application 08/847,887 on which U.S. Patent 5,766,260 issued is a continuation of Application 08/466,607 filed June 6, 1995, now abandoned.

The undersigned has reviewed all of the documents in the chain of title of the patent application identified above and, to the best of the undersigned's knowledge and belief, title is in the assignee, Whiteside Biomechanics, Inc.

The undersigned is empowered to sign this certificate on behalf of the assignee, Whiteside Biomechanics, Inc.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.


Leo A. Whiteside
President, Whiteside Biomechanics, Inc.

St. Louis, Missouri
June 13, 2000

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